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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/671,822

01/20/2004

Henry Daniell

CHL-T103XCD1

8476

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7590

06/20/2006

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EXAMINER

KUBELIK, ANNE R

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/671,822

Applicant(s)

DANIELL, HENRY

Examiner

Anne R. Kubelik

Art Unit

1638

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 05 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

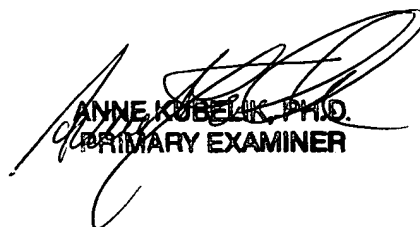
**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Continuation of 11. does NOT place the application in condition for allowance because:

103 over Maliga in view of Davies: Applicant urges that Maliga generally relates to plastid transformation, but does not teach AMPs, and Davies relates to cytotoxic AMPs, but does not teach plastid transformation. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant urges that the specification teaches that plastid transformation had at the time of filing only been used to make insect and herbicide resistant plants, and that it would not be obvious to express AMPs in plastids because they would need to function outside the plant cell, small peptides are not stable in plant cells, and AMPs are toxic to chloroplasts. This is not found persuasive because Applicant presents no evidence that anyone other than the inventor thought that expression of small peptides in plastids was not thought possible. Certainly Smith (see next rejection) thought it possible. Applicant urges that example 1 shows that plants transformed with MSI-99 had up to 96% inhibition of growth of *P. syringae*, which is unexpected in light of the state of the art taught in the specification. This is not found persuasive because Applicant did nothing more than was already suggested in the art for expressing MSI-99; the plastid transformation vector used has no special feature and the claim is not drawn to any special feature. Applicant urges that because AMPs are toxic to bacterial membranes and chloroplasts have bacterial membranes, there was no expectation that plastid transformation with a nucleic acid encoding an AMP could produce such levels of resistance. This is not found persuasive because chloroplast membranes are more than bacterial membranes - they have characteristics of both bacterial and plant membranes. Applicant urges that there was no expectation that constructs encoding magainin would be successful and AMP transformed plastid had never been achieved; furthermore, this rejection is contrary to a rejection made in the parent application. This is not found persuasive because the equivalent 112, 1<sup>st</sup> rejection has been withdrawn in the instant application, due to Applicant's amendment of the claims to limit them to magainin family peptides, of which MSI-99 is just one; is Applicant arguing that the rejection should be reinstated? Applicant urges that Okamoto and Allefs undermine the instant rejection because they teach that expression of AMPs is unpredictable, and specifying a magainin adds another level of nonobviousness. This is not found persuasive because magainins are AMPs that have been successfully expressed in plants. The withdrawal of the rejection for expression of magainins in plant plastids makes Okamoto and Allefs not relevant.

103 over Maliga in view of Smith: Applicant urges that Smith has only two short paragraphs cited for rendering the instant invention obvious; these paragraphs do nothing more than state a goal of AMP production in a plastid. Smith does nothing to bridge the obstacle gap, and while Smith cites a reference to plastid transformation it does not offer an expectation of success. This is not found persuasive because Smith had every expectation of success of AMP expression in plastids. Applicant seems to require that Smith exemplify expression of AMPs in plastids to overcome obviousness. That is not the standard. It is noted that only a reasonable expectation of success is required for determinations of obviousness, as taught in *In re O'Farrell*, 7 USPQ 2d 1673, 1681 (Fed. Cir. 1988).

  
ANNE KUBELIK, PH.D.  
PRIMARY EXAMINER